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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/147,861      | 03/17/1999  | KAZUHIRO NISHIKATA   | TOYAM42.001A        | 2339             |

20995 7590 04/23/2003

KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

PULLIAM, AMY E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1615

DATE MAILED: 04/23/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/147,861

Applicant(s)

NISHIKATA ET AL.

Examiner

Amy E Pulliam

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Receipt of Papers*

Receipt is acknowledged of the Amendment C, received January 13, 2003.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,246,780 to Farer *et al.*.

Farer *et al.* disclose coated particles for use in cosmetic preparations. More specifically, Farer *et al.* teach that one embodiment of their invention is spherical particles having a first coating material applied to the particles, which is a coupling agent selected from the group consisting of silanes and titanates, and thereafter applying a second coating material to the particle (c 2, l 19-30). Farer *et al.* also teach that although the preferred coating is boron nitrate, other suitable coatings are acceptable, including silicone powders, zirconium dioxide, and titanium dioxide, and combinations thereof (c 3, l 57 – c 4, l 13). Additionally, Farer *et al.* teach the use of their coated particles in cosmetic preparations.

Farer *et al.* are discussed above as teaching coated particles for use in cosmetic preparations, wherein the particles can be coated more than once. Farer *et al.* is also discussed

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above as disclosing the same components for the coatings as claimed by applicant. Farer *et al.* does not teach the refractive index of the components in the particle composition. However, because Farer *et al.* teach the same components (silica, zirconia, and titania) as those claimed by applicant, it is the position of the examiner that the refractive indexes are inherent to these components, and therefore must fall within the range claimed by applicant.

Further, as stated above, Farer *et al.* does teach that the preferred embodiment is particles coated with boron nitrate, they also state that other suitable coatings are acceptable, including silicone powders, zirconium dioxide, and titanium dioxide, and combinations thereof (c 3, l 57 – c 4, l 3).

Farer *et al.* do not teach the specific percentages of coatings claimed by Applicant. However, it is the position of the examiner, that absent evidence to the contrary, the determination of the particular percentage of coating material is within the skill of the ordinary worker as part of the process of normal optimization. Furthermore, the teachings of Farer *et al.* successfully function in the same manner as Applicant's claimed invention. Therefore, it is unclear as to the criticality or pertinence of the particularly claimed ranges. It is recommended that Applicant provide comparative data, showing (1) that the materials in the composition of Farer *et al.* do not possess the same refractive indices as claimed by Applicant, and (2) that the difference in percentage of coating materials creates an unexpected and surprising result. Absent this evidence, it is the position of the examiner that one of ordinary skill in the art would have made a cosmetic composition comprising silicon particles with two coatings. It is further the position of the examiner that the slight change in percentages of coating materials does not create a patentable distinction between the cited art and the claimed invention.

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Based on the teachings of Farer *et al.*, one of ordinary skill in the art would have made coated particles for use in cosmetic preparations, comprising spherical particles with a first coating of a silane or titanate, and a second coating layer chosen from many possibilities, including titanium dioxide, zirconium dioxide, and silicon powders. The expected result would be a coated spherical particle which could be used to provide excellent aesthetic properties in a cosmetic preparation such as powders, mascaras, blushes, liquid makeups, and other well known cosmetic formulations. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicant's arguments filed January 13, 2001 have been fully considered but they are not persuasive. Applicants argue that the Farer *et al.* reference teaches layers that are thicker than the layers claimed by Applicant. This is discussed in the above rejection. It is suggested by the examiner that Applicant provide comparative data, demonstrating the unexpected results obtained by the change in percentages. Applicant is reminded that any experimental data presented should be in declaration form, and should be commensurate in scope with the claims.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, alternate Fri 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

A. Pulliam  
Patent Examiner  
Art Unit 1615  
April 17, 2003

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600